

***THIS OPINION WAS NOT WRITTEN FOR PUBLICATION***

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GIANCARLO JOMMI  
and DARIO CHIARINO

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Appeal No. 95-4706  
Application 08/070,869<sup>1</sup>

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ON BRIEF

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Before RONALD H. SMITH, PAK and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

This is an appeal under 35 U.S.C. ' 134 from the decision of the examiner refusing to allow claims 5 through 7 and 11, all of the claims now pending in the application.<sup>2</sup>

The claimed processes prepare certain 5-(4-substituted-phenyl)-oxazolidion-2-ones via the cyclization of certain 1-(4-substituted-phenyl)-2-alkoxycarbonylamino-propanes wherein the substituents on the phenyl moiety are methylthio, methylsulfoxy, methylsulfonyl or a nitro group. The

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<sup>1</sup> Application for patent filed June 3, 1993. According to appellants, this application is a division of application 07/841,075, filed February 25, 1992, now U.S. Patent 5,243,056 (056 patent), issued September 7, 1993, which application is a division of application 07/162,247, filed February 29, 1988, now U.S. Patent 5,105,009 (009 patent), issued April 14, 1992, which application is a continuation of application 06/616,086, filed June 1, 1984, now abandoned.

<sup>2</sup> In the amendment of March 10, 1995 (Paper No. 23), appellants canceled claims 4 and 10, added claim 11 and amended claims 5 and 6 to depend on claim 11.

oxazolidion-2-one products are encompassed by the claims of the parent 56 patent and the herein claimed processes are a step in the processes of forming fluoropropane derivatives claimed in the grandparent 09 patent (*see supra* note 1). According to the examiner, Saari<sup>3</sup> discloses a cyclization process to prepare a 5-(3-hydroxy-phenyl)-oxazolidion-2-one in which the intermediate 1-(3-hydroxy-phenyl)-2-alkoxycarbonylamino-propane is formed *in situ*. Thus, the examiner contends that the claimed invention would have been obvious under 35 U.S.C. § 103 because A one of ordinary skill would reasonably have expected analogous reactants, differing only in substitution remote from the reaction sites, also to cyclize under the same conditions to produce the expected 2-oxalidinones [sic] with a reasonable expectation of success,<sup>@</sup>relying on the authority of *In re Durden*, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985) (answer, page 6).

In the absence of an analysis establishing the *prima facie* obviousness of the claimed invention *as a whole*, thus including consideration of the non-obvious oxazolidion-2-one products obtained by the claimed processes, the examiner's rejection cannot be sustained. *In re Brouwer*, 77 F.3d 422, 426, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1569-71, 37 USPQ2d 1127, 1131-32 (Fed. Cir. 1995).

The examiner's decision is reversed.

*Reversed*

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<sup>3</sup> Saari is listed at page 3 of the answer.

RONALD H. SMITH  
Administrative Patent Judge

CHUNG K. PAK  
Administrative Patent Judge

CHARLES F. WARREN  
Administrative Patent Judge

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John J. Maitner, Esq.  
Group Patent Counsel  
Schering-Plough Corporation  
2000 Galloping Hill Road  
Mail Stop K-6-1-1990  
Kenilworth, NJ 07033-0530